No. 95-26

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

vs.

WESTVIEW INSTRUMENTS, INC., AND
ALTHON ENTERPRISES, INC.
Respondents.

On Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* DOUGLAS W. WYATT IN SUPPORT OF RESPONDENTS

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December 8, 1995

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INTEREST OF *AMICUS CURIAE*

Douglas W. Wyatt ("Wyatt") and Frederick J. Dorchak are members of the firm of Wyatt, Gerber, Burke & Badie, L.L.P., 99 Park Avenue, New York, N.Y. 10016;

Professor Paul M. Janicke is a professor of law at the Intellectual Property Law Institute, University of Houston Law Center, 4800 Calhoun Boulevard, Houston, Texas 77204-6371;

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Except for Professor Janicke, who is an intellectual property law professor, the attorneys representing Amicus Curiae Wyatt are all intellectual property lawyers in private practice.

Each of the attorneys representing amicus Wyatt are interested and have expertise in intellectual property law, including patent law. The private practitioners practice in the field of patent law, represent patent owners, their competitors and other persons and businesses affected by patents.

While amicus Wyatt, Professor Janicke, and Messrs. Kirk, Smith and Dorchak have no interest in any of the parties of this case, or in the outcome of the case as among those parties, amicus Wyatt and the attorneys do have an interest in seeing that the question upon which certiorari was granted in this case is properly decided by this Court.

SUMMARY OF ARGUMENT

Amicus Wyatt urges this Court to affirm the Federal Circuit's *en banc* holding in *Markman*, thereby affirming the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction. The Federal Court also recognized the

exclusive province of the jury to determine factual issues concerning infringement after a claim has been construed by a court.

The Seventh Amendment guarantees a party's right to a jury trial, where properly demanded, in a patent infringement action for damages. But, amicus Wyatt is unaware of any U.S. Supreme Court decision that expressly holds that a dispute as to the meaning of a U.S. patent claim or any term therein must be a jury question. It is the jury's function to determine the underlying facts as to whether there is infringement. It is the court's function to instruct the jury as to the scope of the claim to enable the jury to perform its function of determining the facts concerning the infringement issue.

The U.S. Constitution, Article I, Section 8, Clause 8, gave Congress the right to grant patent rights, and Congress delegated that authority to the U.S. Patent and Trademark Office (PTO). Prior to the Constitution, the states granted patents in the form of special legislation. See, e.g., Evans v. Eaton, 20 U.S. 356, 370 (1822). Congress has also granted patents by way of special legislation. Id. See also Section 2 of the Patent Act of 1832. Congress also enacted statutory requirements for patent clarity, which requirements are in the first instance enforced by PTO examination before granting of a U.S. patent. Patent claims originated as an American advance in patent law, and an issued patent claim is ultimately like a statutory grant. Congress gave the Federal Courts original jurisdiction over any Act of Congress relating to patents 28 U.S.C. § 1338. Nowhere did Congress make an exception to the courts' powers to interpret the scope of patent claims in the same manner as courts would construe a statute.

In our legal system it is well established that statutory construction is a matter of law for judges exclusively, not for juries. Patent claims, like statutes, should also be construed exclusively by judges, not by juries. A long line of decisions of this Court support the principle that questions of construction of patents and patent claims are questions of law to be decided by courts. This Court's decisions also authorize reference to evidence extrinsic to a patent and its administrative prosecution history to assist courts in properly construing patent claims.

Patent claims serve as notice to the public concerning the scope of a patentee's exclusive rights, and patent claims should have one nationally uniform meaning, as judicially construed based on the publicly available patent and prosecution history. Patent claim construction exclusively by courts, not juries, provides uniform patent claim construction and provides courts with flexibility in administering patent cases to streamline patent jury trials. Parker v. Hulme, 18 Fed. Cas. 1138, 1140 (C.C.E.D. Pa. 1849)(No. 10,740)

Unlike patent specifications which are drafted to be understood by persons of ordinary skill in the art under 35 U.S.C. § 112, paragraph 1, patent claims are written by persons expert in drafting claims and not one skilled in the art. Persons skilled in claim drafting and interpretation are patent lawyers, judges and patent examiners and not inventors.

The Federal Circuit was correct in *Markman* and this Court should affirm.

ARGUMENT

I. *AMICUS CURIAE* WYATT URGES THIS COURT TO AFFIRM THE FEDERAL CIRCUIT'S HOLDING IN *MARKMAN*.

In its *en banc* decision in this case the Federal Circuit reaffirmed the long established rule "...that in a [patent] case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)(*en banc*). The Federal Circuit also recognized the exclusive province of the jury to determine factual issues concerning infringement after a patent has been construed by the court.

Amicus Wyatt urges this Court to affirm the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction.

The Seventh Amendment, U.S. Const. Amend. VII, guarantees a party's right to a jury trial, where properly demanded, in a patent infringement action for damages. However, amicus Wyatt believes that the fundamental issue raised by the question upon which this Court has granted certiorari in this case is one which is properly decided by courts, i.e. judges, not by juries. It is the jury's function to determine underlying facts as to whether there is infringement. It is the court's function to instruct the jury as to the scope of a patent claim to enable the jury to perform its function of determining the facts concerning the infringement

issue.

The specific question stated in Markman's petition, upon which this Court granted certiorari, is: "In a patent infringement action for damages, is there a right to jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning?

The question upon which certiorari was granted here subsumes the fundamental issue of whether, in litigation seeking damages for infringement of a U.S. patent, confirmation of the meaning of a U.S. patent claim or any term or terms used therein is properly (1) exclusively within the power of the court, -- i.e., judges, or (2) resolved as a genuinely disputed question of fact -- a classic jury function. This fundamental issue becomes even more germane when such determinations require consideration of evidence extrinsic to the patent document itself or its administrative prosecution history.[1]

For the reasons advanced in this brief, amicus Wyatt advocates that patent claim construction, including determination of the meaning of terms in patent claims, with or without reference to extrinsic evidence, is and should be exclusively within the authority and responsibility of our Federal Courts, i.e., judges. Amicus Wyatt believes that this approach is akin to that used in determining the meaning of federal statutes or terms therein, which are construed exclusively by courts, not by juries. Once the meaning of a statute or a patent claim has been construed, it is the function

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[1] Herein we use the terms "extrinsic evidence" to mean evidence outside the patent document and its prosecution history before the administrative agency.

of the jury to determine as fact whether the accused acts are within the properly construed statute or patent claim.

It is important to consider the fact that the Patent Examiner cannot be examined as to his understanding of the meaning of a word in a claim. E.g. Western Electric Co. v. Piezo Technology, Inc., 860 F.2d 428 (Fed. Cir. 1988). The situation with the Patent Examiner is similar to that of a legislator who cannot be examined as to the meaning of particular words in legislation.

II. THE CONSTITUTIONAL FOUNDATION.

The draftsmen of our Constitution affirmatively conferred upon the U.S. Congress the power "to promote the progress of science and useful arts, by securing for limited times for authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const., Art. I, Sec. 8, Cl. 8. The States in 1789 ratified that delegation of power.

Shortly thereafter, the Constitutional draftsmen and Congress supplemented the original work (the Constitution) with the Bill of Rights, which was ratified by the States in 1791. The Bill of Rights included the Seventh Amendment. But, there is no known constitutional or legislative history which indicates that the Seventh Amendment was in any way intended to change the power conferred upon Congress by the U.S. Constitution, Article I, Section 8, Clause 8, quoted above.

The Constitution gave Congress the exclusive authority to make federal statutory law. U.S. Const., Art. I, Sec. 7 and Sec. 8, Cl. 18. The Constitution also expressly gave Congress the authority to grant patent rights to provide

inventors limited periods of exclusivity to their inventions or discoveries.

III. PATENTS, LIKE FEDERAL STATUTES, ARE CREATURES OF CONGRESS.

Just as the citizens and the States gave Congress the power to make statutes and to grant patent rights, the Congress used that power and delegated its authority to administrative agencies like the U.S. Patent and Trademark Office ("PTO") and its predecessors. Congress delegated its power to grant patent rights to the PTO. See 35 U.S.C. §§1-6. In addition, Congress gave the Federal Courts original jurisdiction over any Act of Congress relating to patents; 28 U.S.C. §1338. Nowhere did Congress make an exception as to the courts' powers to interpret the scope of patent claims in the same manner as courts would construe a statute.

In addition to delegating its authority to the PTO, Congress also under its law-making authority enacted 35 U.S.C. §112, paragraph 2, requiring that patents "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Still further, under 35 U.S.C. §131, Congress called for examination of each patent application to determine whether a patent applicant is entitled to a patent under the law (including 35 U.S.C. §112). Thus, when examining patent applications for compliance with §112 before grant, the PTO carries out the constitutional authority delegated to it by Congress to ensure, insofar as possible, that issued patents have clear meaning.

While in the first instance, the words used in proposed patent claims are drafted and submitted to the PTO by patent

applicants, in the final analysis, it is the PTO, pursuant to its statutorily delegated exercise of the constitutional authority given to it by Congress, which approves the grant of a specific patent claim. In this sense an issued patent claim is ultimately like a statutory grant, 35 U.S.C. §§151-154.

Within the power given to it, Congress could have exercised its constitutional authority by providing that each individual patent would be granted by separate bill which, when passed and signed by the President, would have been a statutory patent grant. As reviewed above herein, we know that Congress chose to delegate that authority to the PTO. Thus, it is clear that U.S. patents are the direct progeny of the statutory delegation of the constitutional power of Congress and for all these reasons are closely akin to statutes *per se*.

IV. STATUTORY CONSTRUCTION IS A MATTER OF LAW FOR JUDGES ONLY, NOT JURIES

Determination of the legal meaning and effect of words of a statute is a matter of law to be determined by courts, i.e., judges, only. See, for example, 2A Singer, Southerland on Statutory Construction, §47.31, and the citations therein. And this general rule still applies even when, in disputes concerning the meaning of a term in a statute, testimony or other evidence extrinsic to the words of the statute itself may be admitted and considered en route to a court's determination. See, for example, *Order of Railway Conductors v. Swan*, 329 U.S. 520, 525 (1947) and 2A Singer, §§48.01-20. The authorities also indicate that courts in construing statutes are not compelled to adopt the trade or commercial meaning of a term, 2A Singer, §§47.31, but courts may construe statutory terms according to their technical or commercial meaning if the statute is directed to

a trade or business in which that meaning is generally accepted. *Id.* at §§47.29, 47.31 and *O'Hara v. Luckenbach S.S. Co.*, 269 U.S. 364, 370-71 (1926). And, disputes over the commonly-used meaning of a term appearing in a statute are to be resolved by courts directly, not by juries. Compare, however, *Nix v. Hedden*, 149 U.S. 305 (1893)(affirming directed verdict).

The Federal Circuit has followed the rule that statutory interpretation is a matter of law strictly for the court. *United States v. John C. Grimberg Co.*, 702 F.2d 1362, 1365,1368 (Fed. Cir. 1983), cited with approval in *Markman*, 52 F.3d at 987 and *Imazio Nursery, Inc. v. Coastal Nursery, et al.*, Appeal No. 94-1450, Slip op. at 9-10 (Fed. Cir., November 3, 1995). Those cases also make the related point that appellate courts review issues of statutory interpretation under a *de novo* standard of review; *Imazio Nursery*, Slip. op. at 9; and *Kane v. United States*, 43 F.3d 1446, 1448 (Fed. Cir. 1994).

V. CONSTRUCTION OF PATENT CLAIMS, LIKE STATUTES, IS A MATTER OF LAW EXCLUSIVELY FOR JUDGES, NOT JURIES

For at least more than one hundred seventy-five years questions of construction of patents and patent claims have been held to be questions of law to be decided by the courts, not by juries. *Lowell v. Lewis*, 15 F. Cas. 1018, 1020 (C.C.D. Mass. 1817) (Story, Circuit Justice, charging jury); *Washburn v. Gould*, 29 F. Cas. 312, 318 (C.C.D.Mass. 1844) (Story, Circuit Justice, charging jury); *Emerson v. Hogg*, 8 F.Cas. 628, 631 (C.C.S.D.N.Y. 1845); *Silsby v. Foote*, 55 U.S. (14 How.) 218, 223-25 (1852); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); *Market Street Cable R. Co. v. Rowley*, 155 U.S. 621, 625

(1894); and *Coupe v. Royer*, 155 U.S. 565, 579 (1895).

Patent claims are part of a patent specification, 35 U.S.C. § 112, ¶ 2, and a U.S. patent specification is directed to "any person skilled in the art to which it [the invention] pertains or with which it is most nearly connected ...." 35 U.S.C. § 112, ¶ 1. See also, *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902).

Patent claims originated as an uniquely American advance in patent law and practice. Stringham, *Outline of Patent Law* § 5000, at 266-67 (1937)("The patent claim, *first developed in the United States*, is now largely relied upon as defining the scope of protections ...") (emphasis added). *See generally*, P.J. Federico, *Origin and Early History of Patents*, 11 J. Pat. Off. Soc'y (1929). Cited with approval in *Markman*, 52 F.3d at 984.

When properly construing patent claims, a court must know what certain terms mean to those skilled in the art to which the claimed invention pertains. Since judges are usually not persons skilled in the art of a patented invention in a particular case, the court usually needs to know the art-skilled definition of any extraordinary terms in a patent claim.

This Court has often said that courts properly may look to a patent's specification for such guidance. See *Hogg v. Emerson*, 52 U.S. (11 How.) 587, 606 (1850); *Bates v. Coe*, 98 U.S. 31, 38-39 (1878); Curtis, G.T., *A Treatise on the Law of Patents*, 4th ed., 1873, § 222, pages 251-252; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403 (1902); *Smith v. Snow*, 294 U.S. 1 (1935); *General Electric Co. v. Wabash Corp.*, 304 U.S. 364, 371-72 (1938); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) and *United States v. Adams*, 303 U.S. 39, 49

(1966). And, a patent claim must be read and interpreted in light of its prosecution history. *Schriber- Schroth*, 311 U.S. at 220-21 (1940) and *Graham v. John Deere*, 383 U.S. at 33.

This Court also long ago also recognized that courts may be aided by the testimony of witnesses and expert witnesses in ascertaining the true meaning of technical terms or terms of art appearing in patent claims.

> Whether a re-issued patent is for the same invention as that embodied in the original patent or for a different one, is a question for the court in an equity suit to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning on the language employed. *Sickles v. Evans*, 2 Cliff., 203.

Where the specification and claim, both in the original and re-issued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the re-issued patent is for the same invention as that described in the original patent or for a different one, is purely a question of construction, but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases, doubtless, arise where the language of the specification and claims, both of the surrendered and re-issued patents, is so interspersed with technical terms and terms of art that the testimony of scientific witnesses

> is indispensible to a correct understanding of its meaning. Both parties in such a case would have the right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony, but the case before the court is not of a character to render it expedient to pursue the inquiry. Bischof v. Wethered, 9 Wall., 814 (76 U.S. XIX, 830); Betts v. Menzies, 4 B. & S.Q.B., 999.

Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 545-46 (1868)(reviewing a decree in equity).

And, in *United Carbon Co. v. Binney & Smith*, 317 U.S. 228, 233 (1942) this Court said:

> Here, as in any other cases, it is difficult for persons not skilled in the art to measure the inclusions or to appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself. The clearest exposition of the significance which the terms employed in the claims had for those skilled in the art was given by the testimony of Weigand, one of the patentees, who respondent called as its witness.

Also see *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals, Inc.*, 315 U.S. 668, 678 (1942).

These precedents certainly authorize reference to evidence extrinsic to a patent itself and a patent's prosecution history as aids to the court in properly understanding the art-skilled meaning of terms used in patent claims, thus facilitating proper judicial construction of patent claims.

A most explicit statement of the rule advocated here by amicus Wyatt was made in *Emerson v. Hogg*, 8 F. Cas. 628, 631 (C.C.S.D.N.Y. 1845)(Betts, Dist. J.) In granting a motion for new trial:[2]

> The specification was objected to at the trial as ambiguous, and one of the particulars urged in support of the objection was, that it was uncertain, upon the face of the specification, whether the patentee claimed a wheel constructed spirally, or only spiral paddles attached to a wheel. The court did not dispose of the point as a question of construction merely, but left a fact to be found by the jury, and indicated the rule of law that would govern when that fact should be ascertained. This was undoubtedly error. It is the province and the duty of the court to settle the meaning of the patent, and if that cannot be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. Gods. Pat. 109, and Supp. 29; Phil. Pat. 249, 252. The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the court. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective

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[2] That case was re-tried before a different judge (Nelson, Dist. J.) and jury in May 1847 and plaintiff-patentee again won a verdict. After judgment on that verdict, defendants Hogg et al appealed the case to this Court on writ of error. This Court affirmed, *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848) and 52 U.S.(11 How.) 587 (1850).

> parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the court had been incorporated in the specification. It accordingly devolved upon the court to dispose of the question as a point of law, and either to decide that the patent was in this respect ambiguous, and therefore void, and direct the jury to find a verdict for the defendants, or to rule against the objection, and decide that the patent conveyed, in this particular, a meaning sufficiently certain, and point out what its claim was. Washburn v. Gould. [emphasis added].

The public need for certainty and national uniformity of the scope of patent claims and statues -- both of which are applicable and may be enforced against any member of the public, be it individual, corporate or other group entity, or even the U.S. government itself -- far outweighs any private parties' desire to have either construed and defined by a randomly selected jury. In the case of a patent, once the patent claim has been construed, both patentee and accused infringer alike enjoy the Seventh Amendment right of a trial by jury on the factual question of whether the accused infringer's acts constitute infringement of the patentee's patent claim.

VI. PATENTEES AND ALL MEMBERS OF THE PUBLIC SHOULD HAVE ONE UNIVERSALLY APPLICABLE CONSTRUCTION OF A PATENT CLAIM.

A. The Public Notice Function of Patent Claims

Patents, like statutes, have important public notice functions. In *Schriber-Schroth Co. v. Cleveland Trust Co.* this court stated

> ... the requirement of the statute [is] that the patentee describe his invention so that others may construct and use it after the expiration of the patent and that it "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not," Permutit Co. v. Graver Corp., 284 U.S. 52, 60 [(1931)].

311 U.S. 211, 214-15 (1940). [bracketed matter added]

In *General Electric Co. v. Wabash Appliance Corp.* this Court stated

> ... Congress requires of the applicant "a distinct and specific statement of what he claims to be new, and to be his invention." Patents, whether basic or for improvement, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the

> encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." The claims "measure the invention."

304 U.S. 364, 369 (1938)(footnotes omitted). See also *Permutit v. Graver Corp*, 284 U.S. 52, 60 (1931) and *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434-35 (1822).

B. While Courts May Consult Extrinsic Evidence in Construing Patent Claims, Such Construction Should, if Possible, Be Based On The Publicly Available Patent and Prosecution History.

If a patentee has complied with the statute, 35 USC § 112, ¶ 2, and the public policies articulated in the above-quoted opinions of this Court, then the public (certainly at least the art-skilled public) should be readily able to understand the meaning of terms in patent claims, and in most instances do so from the face of a patent and its prosecution history. Like claim construction, the question of whether or not a claim complies with the requirements of § 112, ¶ 2, is a matter of law to be decided by courts, not by juries. *Lowell v. Lewis*, 15 F. Cas at 1020; *Carver v. Braintree*, 5 F. Cas. 235, 240 (C.C.D. Mass. 1843)(Story, Circuit Justice); and *Emerson v. Hogg*, 8 F. Cas. at 631.

As explained earlier in this brief, it sometimes may be necessary for courts to refer to evidence extrinsic to the documentary administrative record to confirm the art-skilled definition of certain terms used by an inventor in patent claims. In so doing courts are merely being aided in learning what the art-skilled public already understands from the documentary administrative record. Such inquiries are consistent with the court's duty to decide questions about a patent claim's compliance with § 112, ¶ 2, as a matter of law.

This Court has long held the practices of constructing patent claims in view of the specification, drawings and prosecution history as mandatory. *Schriber-Schroth*, 311 U.S. at 217, 220-21. And quite early this Court held that construction of patent claims was the exclusive province of the courts - not juries. *Bates v. Coe*, 98 U.S. at 38-39. And this Court has encouraged courts to use the assistance of the testimony of expert witnesses in ascertaining the true meaning of technical terms or terms of art appearing in patent claims. *Seymour v. Osborne*, 78 U.S. (22 Wall.) at 546. In all of these efforts to accurately construe patent claims, courts are making essentially the same inquiry. So long as a court's search is limited to seeking the art-skilled meaning of a term used by an inventor in a patent claim, without changing the meaning that is apparent from the patent and its prosecution history, such inquires are of the same nature as resotring to the patent itself and its publicly available prosecution history.

VII. PATENT CLAIM CONSTRUCTION BY COURTS, NOT JURIES, IS NOT ONLY NECESSARY FOR NATIONALLY UNIFORM PATENT SCOPE, BUT CAN HELP STREAMLINE PATENT JURY TRIALS.

For the reasons explained above in this brief, the rule adopted by the Federal Circuit *en banc* in *Markman*, and advocated here by amicus Wyatt, is not only legally sound, but is also logical, practical, and can help streamline patent jury trials which now consume a substantial portion of the time of our federal courts.

> In *Blonder-Tongue Lab. v. University of Illinois Found.*, 402 U.S. 313, 336 n.30 (1971), the Supreme Court noted that in the three year period spanning 1968-1970, only 13 of 382 patent cases going to trial were jury trials. More than half such suits, however, are now tried to juries.[1]

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[1] In the fiscal years 1992-1994, 163 of 274 patent trials were tried to a jury. In fiscal year 1994, 70% of patent trials were tried to juries. 1994 Preliminary Annual Report of the Directory of Administrative Office of the United States Courts, Table C-4 (available from the Administrative Office's Statistics Division); Annual Report of the Directory of the Administrative Office of the United States Courts (temp. Ed. 1993), Table C-4; Annual Report of the Director of the Administrative Office of the United States Courts, Table C-4 (1992).

In re Lockwood, 50 F.3d 966, 980 (Fed. Cir. 1995)(Nies, Cir.

J., dissenting).

Determination of patent claim construction exclusively by courts assures that claim construction will be decided by an authority that will make that claim construction uniformly nationally applicable. Where claim construction is decided by juries, it is often difficult to determine from a general jury verdict, or a jury verdict that includes answers to a few special interrogatories, the specific claim construction accorded a patent claim by a given jury. Thus, it is difficult for the public to know in future cases just what claim construction was adopted by a jury in an earlier case. Conversely, where claim construction is decided by a judge, that claim construction can be explained in a written opinion, which can then be followed, and indeed should be followed under applicable doctrines of collateral estoppel and *stare decisis*.

The parties in any civil action involving a particular patent will bring to the attention of the court any dispute concerning the meaning of a term in a patent claim or construction of the patent claim as a whole, as well as any extrinsic evidence that may relate to any such alleged dispute. But ultimately it is the court, in not only exercising its duty under the *Markman* rule, but also in efficiently administering justice in each case on that court's docket, who will decide when and how the question of patent claim construction should be determined in the case. Depending upon the way in which any disputed claim construction is raised by the parties, the court may decide the question of claim construction as early as reasonably practical during the course of a civil action. For example, the matter of claim construction may be taken up as early as pre-trial scheduling conferences, or otherwise decided on motion for partial summary judgment, in a final pre-trial order, in jury

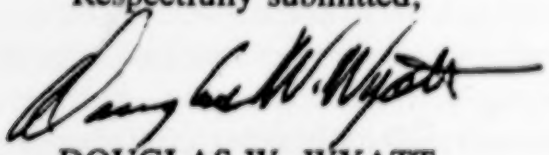
instructions, in a directed verdict, or (hopefully rarely) even after jury verdict by decision on judgment as a matter of law (JMOL). In any given case, it will ultimately be left to the discretion of the trial judge to decide when and how claim construction can best be decided to facilitate efficient handling of the case.

Once claim construction is decided by the court, that construction can readily be used by the parties in tailoring further discovery and trial preparation, and by the jury in more readily deciding the question of patent infringement. All of these advantages of the application of the *Markman* rule provide practical reasons why this legally proper rule should be uniformly followed by our Federal Courts in all patent cases.

CONCLUSION

For all of the foregoing reasons, amicus Wyatt respectfully requests that this Court affirm the Federal Circuit's *en banc* decision in *Markman*, and affirm the principle that construing a patent claim to define the scope of the patent right is a question of law that should be treated, by both the trial and appellate courts, identically to questions of statutory construction.

Respectfully submitted,



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December 8. 1995